

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

## UNITED STATES PATENT AND TRADEMARK OFFICE

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### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Ex parte BART ALAN MELTZER, TERRY ALLEN,  
MATTHEW DANIEL FUCHS, ROBERT JOHN GLUSHKO,  
and MURRAY MALONEY

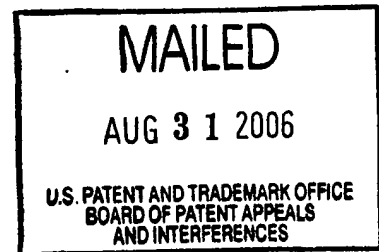
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Appeal No. 2006-1639  
Application No. 09/173,858

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ON BRIEF

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Before KRASS, JERRY SMITH, and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

### **DECISION ON APPEAL**

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-16 and 61-72.

The disclosed invention pertains to documents for commerce in trading partner networks and interface definitions based on the documents.

Representative claims 1 and 61 are reproduced as follows:

1. An interface for transactions among nodes in a network including a plurality of nodes which execute processes involved in the transactions, the interface being stored in a computer readable medium, comprising:

- a machine readable specification of an interface to transaction processes stored in memory accessible by at least one node in the network, including interpretation information providing a definition of an input document, and a definition of an output document, the definitions of the input and output documents comprising respective descriptions of sets of storage units and logical structures for the sets of storage units.

61. A method for programming a commercial transaction in a network, comprising:

- defining a machine readable definition of an input document for a node in the network including resources to execute a process in the transaction, and a machine readable definition of an output document for the node, the definitions of the input and output documents comprising respective descriptions of sets of storage units and logical structures for the sets of storage units; and

- providing interpretation information for the logical structures to the node.

The examiner relies on the following references:

- McKendrick, Joseph, (McKendrick) "Banks begin to play with XML", Bank Technology News, New York, Sep. 1998, Vol. 11, Issue 9, pg. 6, 2 pgs.
- W3C, (W3C) "Extensible Markup Language (XML) 1.0", Feb. 10, 1998, pages 1-37.

The following rejection is on appeal before us:

1. Claims 1-16 and 61-72 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of McKendrick in view of W3C [answer, page 3].

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise,

reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the briefs have not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii)(2004). See also In re Watts, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

It is our view, after consideration of the record before us, that the evidence relied upon by the examiner does support the examiner's rejection of claims 1-16 and 61-72. Accordingly, we affirm.

### **37 C.F.R. § 1.131 Declaration**

I. We consider first the Rule 131 declaration on its merits. See MPEP §715.08. Title 37 C.F.R. § 1.131 provides in pertinent part:

#### § 1.131 Affidavit or declaration of prior invention.

- (a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ **1.42**, **1.43**, or **1.47**, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article **21(2)** is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. **102(e)**. Prior

invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country. Prior invention may not be established under this section if either:

- (1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § 41.203(a) of this title, in which case an applicant may suggest an interference pursuant to § 41.202(a) of this title; or
  - (2) The rejection is based upon a statutory bar.
- (b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

We begin by noting that the filing date of the instant application is Oct. 16, 1998. We note that appellants bear the burden of production to present evidence of an asserted date of invention prior to the instant application filing date. We note that McKendrick is considered as a printed publication published in the United States that qualifies as prior art under 35 U.S.C. § 102(a), and therefore may be antedated by a declaration that complies with the requirements of 37 C.F.R. § 1.131(b). We further note that the critical date to overcome is the Sept. 1998 publication date of the McKendrick reference [McKendrick, see pub. date shown on page 1]. Thus, appellants have to show either: (1) a reduction to practice, or (2) conception of the invention plus diligence to actual or constructive reduction to practice

before the critical date. 37 C.F.R. § 1.131(b). We note that appellants assert possession of the invention before the critical date by presenting evidence purportedly demonstrating an actual reduction to practice prior to March 11, 1998 [see Rule 131 declaration received Jan. 31, 2005, including Exhibit A].

In the Rule 131 declaration, appellants make the following assertions in reference to a “memorandum” that is presented as Exhibit A [Rule 131 declaration, pages 1 and 2]:

- Prior to March 11, 1998, we had implemented a registry for trading partners. The registry was used in a method, also implemented prior to March 11, 1998, in a form sufficient to demonstrate that the method would work for its intended purpose, for establishing transactions among trading partners in a network, comprising: maintaining a registry of machine-readable specifications specifying business services offered by trading partners, the machine-readable specifications including at least one of definitions of, and references to definitions of, services offered and at least one of definitions of, and references to destinations of, documents to be exchanged with such services by trading partners; and providing, in response to a request, one or more of the machine-readable specifications from said registry is via a communication network to a requesting node.
- Attached hereto as Exhibit A is an excerpt of a memorandum, which I am informed, or know from personal knowledge, was written by co-inventor Glushko, prior to March 11, 1998. Exhibit A includes the statement “In particular, the eCo server has now subsumed the registry and query services that had been envisioned as part of the Taxonomy of Everything in our proposal.” This comment establishes that the registry and supporting services had been implemented at the time the memorandum was written.
- The implementation of the method described above occurred within the United States prior to March 11, 1998.
- Work on the system including the registry continued without interruption from at least as early as March 11, 1998, through the filing date of the parent U.S. patent application No. 09/173,854 on October 16, 1998.

It is well established that proof of actual reduction to practice requires demonstration that the embodiment relied upon as evidence of priority actually worked for its intended purpose. Newkirk v. Lulejian, 825 F.2d

1581, 1582, 3 USPQ2d 1793, 1794 (Fed. Cir. 1987) citing Wiesner v. Weigert, 666 F.2d 582, 588, 212 USPQ 721, 726 (CCPA 1981) (“an invention is not reduced to practice until its practicability or utility is demonstrated pursuant to its intended purpose”); Chandler v. Mock, 150 F.2d 563, 565, 66 USPQ 209, 211 (CCPA 1945) (“reduction to practice of a complex mechanical device ... requires that the device was subjected to a test under actual working conditions which demonstrated not that the device might work, but that it actually did”). Affidavits and declarations fail in their purpose when they recite conclusions with few facts to buttress the conclusions. In re Brandstadter, 484 F.2d 1395, 1404, 179 USPQ 286, 292 (CCPA 1973).

In the instant case, we have carefully considered the Rule 131 declaration and evidence (Exhibit A) and we do not agree that the evidence shows an actual reduction to practice of the instant claimed invention prior to March 11, 1998. We note that it is appellants’ burden to clearly explain how the proffered evidence (i.e., Exhibit A) shows completion of the invention. See In re Borkowski, 505 F.2d 713, 719, 184 USPQ 29, 33-34 (CCPA 1974) (“It was appellants’ burden to explain the content of these notebook pages as proof of acts amounting to reduction to practice. That was not done.”). Vague and general statements in a declaration with respect to what the exhibits show along with the assertion that the exhibits describe a reduction to practice are insufficient. See id. at 718, 184 USPQ at

33 (vague and general statements amount to mere pleading, unsupported by proof or showing of facts). After careful consideration of the evidence before us, we conclude that appellants have failed to provide a factual showing that the embodiment relied upon actually worked for its intended purpose as required to demonstrate an actual reduction to practice.

Furthermore, we find that appellants have failed to completely read the language of the instant claims on the proffered Exhibit A evidence provided in the declaration. In particular, we note that appellants have failed to point to specific portions of Exhibit A that demonstrate actual reduction to practice of the instant claimed “interpretation information providing a definition of an input document, and a definition of an output document, the definitions of the input and output documents comprising respective descriptions of sets of storage units and logical structures for the sets of storage units” [claim 1, emphasis added]. While we recognize that XML (i.e., Extensible Markup Language) may provide Document Type Definitions (see e.g., W3C, p. 9, §2.8), the mere use of XML does not disclose input and output documents, per se. We have considered appellants’ argument that the “forms and messages” disclosed in Exhibit A correspond to “input and output messages or documents” as part of CBL [brief, page 8, emphasis added]. However, we note that appellants have



failed to provide a copy of the CBL first draft to be considered as evidence of actual reduction to practice.

We recognize that an accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. Ex parte Ovshinsky, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989) [emphasis added]. In the instant case, we note that appellants have also failed to explain how dependent claims 2-16 and 62-72 are supported by Exhibit A. In the alternative, appellants have failed to provide support for the missing dependent claim limitations in the declaration itself, so as to conclusively show possession of the complete instant claimed invention before the critical date. For at least the aforementioned reasons, we conclude that the character and weight of the evidence submitted pursuant to 37 C.F.R. § 1.131(b) is insufficient to show actual reduction to practice before the critical date of Sept. 1998. Accordingly, we consider the McKendrick reference as prior art, *infra*.

II. We consider next the examiner's rejection of claims 1-16 and 61-72 as being unpatentable over the teachings of McKendrick in view of W3C [answer, page 3].

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of

obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. 277 F.3d at 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of

ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

### **As per claims 1-16**

Since appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will consider independent claim 1 as the representative claim for this rejection. See 37 C.F.R. § 41.37(c)(1)(vii)(2004).

At the outset, we note that Appellants have made an admission in the reply brief at page 1, ¶4:

This reply focuses on the McKendrick reference, because the second WSCI [*sic*, "W3C"] reference serves only to connect XML to the claim wording, "respective descriptions of sets of storage units and logical structures for the sets of storage units."  
Appellants and Respondent agree that this wording reads on XML and XML reads on this wording [emphasis added].

Thus, appellants have conceded that W3C teaches "respective descriptions of sets of storage units and logical structures for the sets of storage units," as claimed [reply brief, page 1, ¶4; claims 1 and 61]. With respect to the remaining limitations of representative claim 1, appellants argue that McKendrick's disclosure of the use of XML defines only one document, and does not disclose an interface to a transaction [brief, pages 9 and 10]. Appellants argue that McKendrick's disclosure of purchase orders and invoices does not teach the claimed input and output documents and associated definitions [brief, page 10; claim 1]. Appellants further argue that McKendrick does not teach or enable a machine-readable specification of an interface, as claimed [brief, page 11, claim 1].

In response, the examiner notes that McKendrick discloses XML financial transactions on the Internet such as purchase orders and invoices [answer, page 20; McKendrick, pages 1-2]. The examiner asserts that

McKendrick implies an interface for business transactions since the online business transactions must be performed with some type of interface to process the purchase orders and invoices [*id.*]. The examiner corresponds McKendrick's purchase orders and invoices to the instant claimed input and output documents [*id.*]. The examiner argues that the purchase orders and the invoices include definitions because they are XML documents. The examiner relies upon W3C as teaching the recited "definitions of the input and output documents comprising respective descriptions of sets of storage units and logical structures for the sets of storage units" [*id.*, claim 1]. The examiner concludes that the modification of McKendrick with W3C would provide the specific syntax needed to implement an XML structure as a mechanism to define the logical structures and support the use of storage units utilized in business documents to effectively perform business services [answer, page 20].

We note that McKendrick teaches a web site interface for performing "T. Rowe Price" financial transactions as shown in the illustration on page 2 of the reference. We find that the instant claimed "interface for transactions among nodes in a network" clearly reads upon this disclosure, noting that the Internet includes "a plurality of nodes" and also that web pages are stored on a computer readable medium, as claimed [claim 1]. We agree with the examiner that the instant claimed input and output documents

broadly read upon McKendrick's XML purchase orders and invoices [see last paragraph on page 2]. In particular, we note that a purchase order is clearly an input document from the perspective of a business providing products or services to customers over the Internet. We further note that an invoice is an output document when that same business bills the customer for the provided product or service. We find that the McKendrick's use of XML (as defined by the W3C XML specification) to perform financial transactions on the Internet clearly meets the language of the claim that recites "a machine readable specification of an interface to transaction processes stored in memory accessible by at least one node in the network, including interpretation information providing a definition of an input document, and a definition of an output document" [claim 1]. We note that XML is a machine readable specification that allows the author to define his own tags and his own document structure [see W3C, p. 13, ¶3 "Logical Structures"]. Because a "well-formed" XML document is a document that conforms to XML syntax rules, we find that McKendrick's XML purchase orders and invoices are clearly associated with corresponding XML declarations (i.e., definitions) [see e.g., W3C, p. 8, ¶2.8]. We note that appellants have admitted *supra* that the W3C reference teaches the remaining limitations of "respective descriptions of sets of storage units and logical structures for the sets of storage units," as claimed [reply brief, page 1, ¶4; claim 1]. Therefore, we

agree with the examiner that the combination of McKendrick and W3C teaches all that is claimed.

### **Hindsight**

Appellants further argue that the examiner has impermissibly relied upon hindsight in formulating the rejection [brief, pages 10 and 11; reply brief, page 8].

We disagree. We note that the Court of Appeals for the Federal Circuit has determined that the motivation to combine under §103 must come from a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. Ruiz v. A.B. Chance Co., 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000) [emphasis added]. In the instant case, we find that the use of the W3C XML specification (and associated XML definitions and syntax) is inherent in McKendrick's XML-based web pages and transaction documents. We further find that because XML is a recognized standard, such use of XML would have been well within the general knowledge of a person of ordinary skill in the field of the invention. Accordingly, we conclude that the examiner has sufficiently explained why an artisan

possessing knowledge of McKendrick and W3C at the time of the invention would have been motivated to look to W3C, to select particular elements, and to combine them with McKendrick. Accordingly, we find no evidence of record to support appellants' assertion that the examiner has impermissibly used hindsight in formulating the rejection.

Therefore, we agree with the examiner that McKendrick and W3C teach all the limitations disputed by appellants in the briefs. Accordingly, we will sustain the examiner's rejection of representative claim 1. We note that dependent claims 2-16 fall with independent claim 1 since appellants have not separately argued the patentability of these claims. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). See also 37 C.F.R. § 41.37(c)(1) (vii)(2004). Accordingly, we will also sustain the examiner's rejection of these claims for the reasons set forth by the examiner in the rejection.

### **As per claims 61-72**

Since appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will consider independent claim 61 as the representative claim for this rejection. See 37 C.F.R. § 41.37(c)(1)(vii)(2004).



Appellants argue: “the Examiner’s words that McKendrick ‘does not disclose’ what is claimed make a good argument for reversal” [brief, page 12]. Appellants further argue that the mention of purchase orders and invoices as potential future uses for XML is an improper basis for a §103 rejection [brief, page 12, emphasis added].

We note that the examiner states in the rejection of claim 61 that McKendrick does not explicitly disclose that the definitions of the input document and the output document comprise respective descriptions of sets of storage units and logical structures for the sets of storage units [answer, page 4].

The Court of Appeals for the Federal Circuit has determined that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, the examiner’s rejection is based upon the combination of the McKendrick and W3C references. We have previously addressed the issue of input and output documents and associated XML definitions [see the discussion of claim 1 *supra*]. We note that McKendrick teaches the notoriously well known use of purchase orders and invoices [page 2, last paragraph] and both McKendrick and W3C disclose the use of XML. With respect to appellants’ argument that McKendrick merely discloses potential future uses for XML,

we find that McKendrick provides a compelling suggestion to an artisan that it would be advantageous to implement purchase orders and invoices on the Internet using XML [see McKendrick, page 2, last paragraph, e.g., "XML will allow a rich array of business applications to be implemented"; see also brief, page 12]. We note again that appellants have conceded that the W3C reference teaches the remaining limitations of "respective descriptions of sets of storage units and logical structures for the sets of storage units," as claimed [reply brief, page 1, ¶4; claim 61]. Therefore, we agree with the examiner that the combination of McKendrick and W3C teaches all that is claimed.

Appellants restate their argument that the examiner has impermissibly relied upon hindsight in formulating the rejection [brief, page 12; reply brief, page 9]. We note that we have fully addressed this issue with respect to the rejection of claim 1, as discussed *supra*.

Therefore, for at least the aforementioned reasons, we find that McKendrick, as modified by W3C, teaches all the limitations disputed by appellants in the briefs with respect to representative claim 61. Accordingly, we will sustain the examiner's rejection of independent claim 61. We note that dependent claims 62-72 fall with claim 61 since appellants have not separately argued the patentability of these claims. Therefore, we will

sustain the examiner's rejection of these claims for the reasons set forth by the examiner in the rejection.

In summary, we have sustained the examiner's rejection of all claims on appeal. Therefore, the decision of the examiner rejecting claims 1-16 and 61-72 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED.

  
Errol A. Krass  
Administrative Patent Judge

  
Jerry Smith  
Administrative Patent Judge

  
Howard B. Blankenship  
Administrative Patent Judge

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